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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,127	11/28/2006	Isabelle Dubois	38624-100474	9636
23644 7590 04/15/2010 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER				
MCALL, JOSEPH				
ART UNIT		PAPER NUMBER		
1793				
NOTIFICATION DATE		DELIVERY MODE		
04/15/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

Office Action Summary

Application No.

10/550,127

Applicant(s)

DUBOIS ET AL.

Examiner

Joseph V. Micali

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Application

The amendments/argumentation filed on March 18th, 2010 have been entered. Claims 1-17 remain pending and presented for examination on the merits. The previous claim objections have been withdrawn as per applicant's amendments.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 5-7, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,447,563 by van Hoorn, in view of US Patent No. 5,100,697 by Nielsen.

With respect to claim 1, van Hoorn is drawn to a release composition (**title**). Specifically, van Hoorn discloses a composition (**claim 1**) comprising a fatty acid ester with between 4 and 24 carbon atoms (**column 3, lines 12-16**) and a neopentyl polyol containing three hydroxyl groups, such as trimethylolpropane and pentaerythritol (**column 3, lines 5-11**). Thus, as van Hoorn discloses such a release composition, van Hoorn also discloses a process involving application of such a release composition to moulds (**last line of abstract, and column 4, lines 1-8**).

However, van Hoorn is silent with regards to the newly added limitations requiring the composition to be non-emulsified.

Nielsen is drawn to a method for improving the release of a moulded concrete body from the mould (**title**). Specifically, Nielsen discloses use of an oil-in-water emulsion composition (water in an amount of 10-90% by weight of the total composition), similar to the van Hoorn reference; however, Nielsen also discloses another option – use of a non-emulsified composition comprising esters of aliphatic carboxylic acids with mono- or dihydric alcohols (**column 2, line 66 – column 3, line 22**).

At the time of invention it would have been obvious to a person of ordinary skill in the art to perform the process of van Hoorn including use of a non-emulsified composition, in view of the teaching of Nielsen. The suggestion or motivation for doing so would have been a simple substitution of one known element for another to obtain predictable results, as Nielsen discloses

both the van Hoorn manner as well as the instant invention manner of a non-emulsified composition (**Nielsen, column 7, line 57 – column 8, line 5**).

With regards to the limitation of less than 0.2% by weight water, Nielsen discloses a composition not containing any water, and thus, 0.0% is less than 0.2% by weight (**column 7, line 57 – column 8, line 5**).

With respect to claim 5, van Hoorn discloses a neopentyl polyol containing three hydroxyl groups, such as trimethylolpropane and pentaerythritol (**column 3, lines 5-11**).

With respect to claims 6-7, van Hoorn discloses a fatty acid ester with between 4 and 24 carbon atoms, overlapping the currently claimed range of 16 to 20 carbon atoms, with the acid ester being unsaturated (**column 3, lines 12-16**). See **MPEP 2144.05 [R-5] Overlap of Ranges**.

With respect to claim 9-10, van Hoorn discloses the ester being present in a proportion of 10-50% by weight, as van Hoorn discloses water being selected at 5% by weight (**column 3, line 35**) and the alcohol being selected at 5%-45% by weight (**claim 1**) with the rest of the composition comprising the ester. Thus, such a range overlaps both of the currently claimed ranges (10-100% and 20-60%). See **MPEP 2144.05 [R-5] Overlap of Ranges**.

5. Claims 2-4 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,447,563 by van Hoorn in view of US Patent No. 5,100,697 by Nielsen, as applied to claims 1, 5-7, and 9-10 above, and further in view of US Patent No. 5,523,025 by Erilli.

With respect to claims 2 and 4, van Hoorn, as combined, is silent with regards to the addition of a terpene derivative and/or a component of inorganic origin.

Erilli is drawn to a microemulsion light duty liquid cleaning composition (**title**). Specifically, Erilli discloses the addition of terpenes to such a composition as well as the addition of components of inorganic origin, such as paraffinic and aromatic oils (**column 2, lines 10-12, column 4, lines 35-36, and column 5, lines 14-16**).

At the time of invention it would have been obvious to a person of ordinary skill in the art to perform the modified process of van Hoorn including the addition of a terpene derivative and a component of inorganic origin, in view of the teaching of Erilli. The suggestion or motivation for doing so would have been to improve the removal ability of the composition by adding a strong removal solvent as well as improving the component dissolvability into the composition (**Erilli, column 2, lines 10-12, column 4, lines 35-40, and column 5, lines 3-13**).

With respect to claims 3 and 11, Erilli discloses the terpene derivative being a terpene alcohol, such as terpineol (**column 5, lines 14-16**).

With respect to claim 12, Erilli discloses the terpene derivative being a terpene alcohol, such as terpineol, specifically alpha-Terpineol (**column 5, lines 14-16**). By disclosing such an isomer, one having ordinary skill in the art at the time the invention was made would have been able to select multiple isomers to be used, with the suggestion or motivation of a substitution/addition of equivalents, as the properties of an isomer are dependent on the functional group, which in this case would be consistent throughout any and all of the possible isomers, i.e. the hydroxyl group of the alcohol.

With respect to claim 13, Erilli discloses the terpene derivative being present in an amount of 0 to 80% (**column 4, lines 35-40**), overlapping the currently claimed range of 0 and 90% by weight. See **MPEP 2144.05 [R-5] Overlap of Ranges**.

With respect to claim 14, Erilli discloses components of inorganic origin, such as paraffinic and aromatic oils (**column 4, lines 35-36, and column 5, lines 14-16**).

With respect to claim 15, Erilli discloses the component of inorganic origin being present in an amount of 0 to 80% (**column 4, lines 35-40**), especially 10% (**column 5, lines 14-16**), overlapping the currently claimed range of 0 and 90% by weight. See **MPEP 2144.05 [R-5]**

Overlap of Ranges.

With respect to claims 16-17, the modified method of van Hoorn discloses the composition having between 10-50% by weight ester and 0-80% by weight terpene derivative (**van Hoorn, column 3, line 35 and claim 1, and Erilli, column 4, lines 35-40**) overlapping with the currently claimed ranges of 30-90% or 35-50% by weight ester and 10-70% or 50-65% terpene derivative. See **MPEP 2144.05 [R-5] Overlap of Ranges**.

6. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,447,563 by van Hoorn in view of US Patent No. 5,100,697 by Nielsen, as applied to claims 1, 5-7, and 9-10 above, and further in view of US Patent No. 6,176,914 by Feustel et al.

With respect to claim 8, van Hoorn, as combined, is silent with regards to the ester being a tall oil fatty acid ester, although disclosing an unsaturated fatty acid ester with between 4 and 24 carbon atoms.

Feustel is drawn to aromatic compound-free solvent for printing inks (**title**). However, Feustel discloses employing fatty acid esters as release agents (**column 2, lines 34-35**), with such fatty acid esters including unsaturated tall oil fatty acid esters (**column 3, lines 20-43**).

At the time of invention it would have been obvious to a person of ordinary skill in the art to perform the modified process of van Hoorn including the addition of a tall oil fatty acid ester as the ester, in view of the teaching of Feustel. The suggestion or motivation for doing so would have been to select an ester to improve solubility of the composition as well assist as a release agent (**Feustel, column 2, lines 34-35, and column 3, lines 20-21**).

Response to Arguments

7. Applicant's arguments with respect to the current claim set have been considered but are moot in view of the new ground(s) of rejection.

With regards to applicant's argumentation on the rejection using the van Hoorn reference solely, such argumentation is no longer valid, as the newly added limitation of a non-emulsified composition led the examiner to give further search and consideration to independent claim 1, where upon searching, found the reference of Nielsen to combine with van Hoorn. Nielsen is analogous art, drawn specifically to a method for improving the release of a moulded concrete body from the mould. Furthermore, Nielsen discloses several compositions; one of which is in non-emulsified form. Finally, stemming from that, the limitation of water amount is encapsulated by such a teaching, as Nielsen's non-emulsified composition requires no water. Thus, argumentation on the point is not persuasive, given the reference of Nielsen.

Applicant then addresses the secondary rejections. Applicant argues Erilli is non-analogous art. In response to applicant's argument that Erilli is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977

F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Here, Erilli is drawn to a removal composition, and thus, the components of said composition are reasonably pertinent to a release composition, given the similarity of the problem. Next, applicant argues Feustel as non-analogous art. However, this argumentation is not valid, as Feustel is reasonably pertinent to the particular problem with which the applicant was concerned, due to the fact that Feustel explicitly states knowledge of using fatty acid esters as release agents in compositions.

Thus, on the whole, applicant's argumentation is not persuasive.

Conclusion

8. Claims 1-17 are rejected.
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph V. Micali whose telephone number is (571) 270-5906.

The examiner can normally be reached on Monday through Friday, 7:30am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry A. Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph V Micali/
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